

09/666,655
Art Unit 2623
8798

REMARKS

This Amendment is submitted in response to the Office Action mailed on July 15, 2003. Claims 1 - 41 are pending, and all stand rejected at present.

09/666,655
Art Unit 2623
8798

RESPONSE TO 102 - REJECTIONS

Claims 1 - 3, 16, 18 - 22, 25 - 29, 32, and 35 - 39 were rejected on grounds of anticipation, based on Browning.

Claim 1

Claim 1 recites:

1. A hand-held control device for controlling a terminal connectable by a communications network to an addressed resource, the device comprising:

address input means for scanning a text address of the resource;

and

command output means for uploading address information from the device to the terminal and causing the terminal to connect to the addressed resource.

Applicant submits that the recited "command input means" is not found in Browning. Applicant points out that this claim phrase is of means-plus-function type. As such, section 112 dictates how the claim phrase shall be interpreted:

. . . .

An element in a claim for a combination may be expressed as a **means** . . . for performing a specified function without the recital of structure, material, or acts in support thereof,

09/666,655
Art Unit 2623
8798

and

such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Applicant points out that the Specification states that the hand-held device scans text, and also develops a command appropriate for the text. For example, if the text is a URL, the command would be to launch a browser. (Specification, page 7, bottom.) As another example, if the text is an e-mail address, the command would be an appropriate command, such as launching an e-mail program. (Specification, page 9, lines 21, 22.)

Then the scanned text is transmitted to the stationary terminal, which obeys the command, as by launching the browser and fetching the web page identified by the URL.

Browning does not show that. In his system, the hand-held device either transmits one, or several, URLs to the stationary terminal. If several URLs are transmitted, the order in which they are processed depends on the choice of the user: they can be alphabetically processed, processed in the order received, and so on. (Column 4, lines 3 - 14.)

In addition, a dedicated "software communications agent" is present in Browning, which handles the URLs. (Column 3, line 45 et seq.) That agent has two modes of operation:

09/666,655
Art Unit 2623
8798

- 1) user-controlled mode (column 4, lines 23 et seq.) and
- 2) automatic mode (column 4, line 32 et seq.)

In the former mode, the user orders the agent to process the URL. The user does this using the hand-held device, and selects one of the URLs displayed by the stationary terminal. (Column 4, line 28 et seq.)

In the latter mode, the agent automatically processes the URL received. (Column 4, line 21 et seq.) If multiple URLs were received from the hand-held device, then the agent displays one, then another, and so on, presumably in the order discussed above. (Column 5, line 14 et seq.)

Applicant submits that the operation of Browning does not correspond to "the corresponding structure, material, or acts described in the specification," as required by section 112, and thus that claim 1 does not read on Browning. For example, the Specification states that a command code is developed upon scanning and recognizing the text. Browning does not show that.

As another example, the Specification states that the hand-held device can store multiple instances of scanned text, which will be called URLs for simplicity. (Specification, page 5. lines 4 - 9.) However, only one URL is transmitted at a time. When it is, the associated command causes the stationary terminal to take action, such as fetching the web page identified by the URL.

09/666,655
Art Unit 2623
8798

As just explained, Browning does not do that. Two cases should be distinguished: single URLs and multiple URLs.

In Browning, if a single URL is transmitted, the action taken by the stationary terminal depends on whether user-controlled mode automatic mode is selected.

-- If the former, the stationary terminal waits for a signal from the user. That does not correspond to the Specification's description.

-- If the latter, the stationary terminal automatically fetches the web page. But it does so because "automatic mode" was selected, not because of a command issued by the hand-held unit. That does not correspond to the Specification's description.

If **multiple** URLs are transmitted, the following occurs:

-- In user-controlled mode, the stationary terminal lists the URLs, in some order, and waits for the user to choose one. That does not correspond to the Specification's description.

-- In automatic mode, the stationary terminal lists the URLs, and processes them one-by-one. That does not correspond to the

09/666,655
Art Unit 2623
8798

Specification's description either, at least because, in the Specification, each URL is processed as it is transmitted.

THEREFORE, Applicant submits that Browning does not show the "command input means" of claim 1, as that "means" is interpreted under section 112. The preceding four examples illustrate that Browning does not correspond to Applicant's Specification.

In this connection, Applicant points out that the language of the claim phrase in question is not given "the broadest possible interpretation," but is interpreted as required by section 112.

Claim 2

The Office Action asserts that claim 2 is "inherent" in Browning. MPEP § 2112 states:

EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE
TENDING TO SHOW INHERENCY.

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art.

Applicant requests that the "basis in fact and/or technical reasoning" be provided, as required by this MPEP section.

One reason for this request is that Browning's software "agent" retrieves e-mail messages and web pages. (Column 3, lines

09/666,655
Art Unit 2623
8798

36 - 44.) Thus, the "agent" decides the identity of the scanned text (ie, URL or e-mail address, for example), if any such decision is made.

However, that "agent" runs on Browning's stationary terminal, not on the hand-held device. The language of claim 2 states that the "recognition means" is "comprised" of the "hand-held control device."

Thus, it appears that if anything performing the function of the "means" of claim 2 is found in Browning (and that has not been shown, only asserted to be "inherent"), that thing appears to run on the stationary terminal, or computer. Claim 2 does not recite that.

Claim 3

A similar comment applies to claim 3. Browning, column 4, lines 60 - 64, is cited to show claim 3. However, that passage in Browning discusses a "port" which "interprets" signals. But that "port" is located in the stationary terminal, not the hand-held device.

Claims 16 and 18 - 22

Claims 16 and 18 - 22 are considered patentable, based on parent claim 1.

09/666,655
Art Unit 2623
8798

Claims 25, 26

The discussion above applies to claims 25 and 26.

Claim 27

The rejection of claim 27 is not contested.

Claims 28 and 29

Claim 28 recites:

28. A method according to claim 27,
further comprising

recognizing the nature of the
addressed resource from the format
of the scanned text address.

Applicant cannot locate the claimed process of recognizing, and requests, under 37 CFR §§ 1.104(c)(2) and 35 U.S.C. § 132, that the PTO specifically identify that process in Browning.

Applicant also requests that the "launch code" of claim 29 also be identified in Browning. One reason is that Browning's "agent" appears to handle all Browning's tasks. Thus, no other programs need be "launched."

102 - REJECTION OF CLAIMS 23, 24, 40, and 41

Applicant acknowledges the rejections.

09/666,655
Art Unit 2623
8798

103 - REJECTION OF CLAIMS 4, 5, 17, 30, AND 31

Claims 4 and 30

Claim 4 was rejected, based on Official Notice.

Point 1

In response to the invocation of Official Notice, the undersigned attorney respectfully traverses the Official Notice, and requests a citation of evidence showing the recited appending. (See MPEP § 2144.03.)

One reason is that the PTO states that one benefit of the "appending" is alleviation of processing load of the terminal. However, Applicant submits that this "benefit" is contrary to common sense. The hand-held device in Browning is battery powered. This "benefit" will drain the batteries. That is not desired.

Point 2

The device of Official Notice merely removes the necessity of showing the Noticed element in the prior art. However, a teaching for combining that element with other references still must be shown. No teaching has been given.

Assertions that "more efficient" operation is obtained, and the like, are not teachings under section 103. They merely point to characteristics of a combination, but after the combination is

09/666,655
Art Unit 2623
8798

made. That is not a teaching for making the combination in the first place, which is required.

This applies to claim 30.

Claims 5 and 31

In response to the invocation of Official Notice, the undersigned attorney respectfully traverses the Official Notice, and requests a citation of evidence showing the recited temporary storage. (See MPEP § 2144.03.)

The comments made with regard to claim 4 apply here.

This applies to claim 31.

Claim 17

The rejection, in essence, is base on "design choice." However, "design choice" is based on the rationale that the claimed invention merely substitutes one known element for an equivalent element. That is not so in this case.

The claimed oblique angle provides the operating feature that the scanner can be held like a pencil. As Figure 2 indicates, if the scanning surface is parallel with the image-to-be-scanned, then the body of the scanner can stand at an angle, like a pencil.

That is not true of all angles, nor of all positioning of the scanning surface.

From another point of view, the rejection, in essence, is

09/666,655
Art Unit 2623
8798

asserting that Applicant merely chose one of several known equivalents. Applicant thus points to MPEP § 2144.06, which states:

In order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on . . . the mere fact that the components at issue are functional or mechanical equivalents.

Applicant requests that the recognized equivalency be shown in the prior art.

From yet another point of view, MPEP § 2144(f) states:

C. Rearrangement of Parts

. . . .

However, "The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is **not by itself sufficient** to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." [Citation.]

Applicant requests that a motivation be provided.

103 - REJECTION OF CLAIMS 6 - 15 AND 33 - 34

These claims were rejected as obvious, based on Browning and Kasabach.

09/666,655
Art Unit 2623
8798

Claim 6

No teaching has been given in support of the combination. The fact that "greater functionality and versatility" is obtained is not a teaching, for several reasons.

One is that "greater functionality and versatility" would seem to be obtained by using Browning and Kasabach **separately**. The PTO has not shown how combining parts of them **into a single unit** provides still greater functionality etc.

A second reason is that "greater functionality and versatility" is a naked conclusion, unsupported by evidence. Evidence is required. For example, what is the standard of comparison ? That is, how does one determine whether, in fact, "functionality and versatility" are actually increased ?

A third reason is that "greater functionality" appears to be a meaningless phrase. Does that mean that more "functions" are now present in Browning's device, as modified ? If so, why is that desirable, and where is a teaching so stating ?

A fourth reason is that the rationale does not follow the CAFC's decision of In re Dembiczak, 175 F. 3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999).

In brief, Dembiczak states that

-- **objective evidence** of a teaching for combining references must be provided;

09/666,655
Art Unit 2623
8798

- the Examiner's speculation does not qualify as objective evidence;
- numerous sources can provide a teaching to combine references;
- knowledge of one skilled in the art can act as a source;
- however, THE RANGE OF SOURCES AVAILABLE DOES NOT DIMINISH THE REQUIREMENT FOR ACTUAL EVIDENCE;
- broad conclusory statements by the Examiner do not qualify as evidence; and
- "particular factual findings" as to the teaching are required, and gives reasons why **facts** are necessary.

In addition, the fact that both references involve the Internet is not dispositive, and does not lead to their combination. At best, that shows that the references lie in analogous arts.

Claim 7

The claimed "tilt switch" has not been shown in the prior art.
MPEP 2143.03 states:

To establish prima facie obviousness . . . **all the claim limitations** must be taught or

09/666,655
Art Unit 2623
8798

suggested by the prior art.

Further, the Office Action relies on "tilt switches" for "sensing orientation." However, the Office Action has not shown "sensing orientation" in Kasabach. Thus, the Office Action is selecting prior art, based on Applicant's claim, which is hindsight. That is, Applicant's claim recites sensing orientation, and is plainly the motivation for the Office Action to cite "tilt switches."

Claim 8

Kasabach may suggest accelerometers, but that is not the issue. A teaching is required for combining Kasabach's accelerometers with Browning.

Claims 9 - 15, 33, and 34

The rejections of these claims only assert that subject matter of the dependant claims is found in Kasabach. But that is not the question.

A teaching is required for combining the references. As explained above, none has been given.

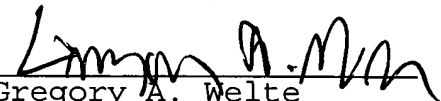
09/666,655
Art Unit 2623
8798

CONCLUSION

Applicant requests that the rejections to the claims be reconsidered and withdrawn.

Applicant expresses thanks to the Examiner for the careful consideration given to this case.

Respectfully submitted,


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October 15, 2003
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ATTACHMENT: PROPOSED DRAWING AMENDMENT